

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JEFFREY THOMAS KREULEN  
and  
WILLIAM SCOTT SPANGLER

---

Application 09/848,430

---

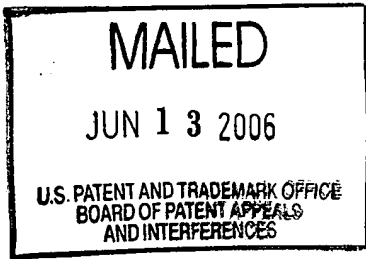
ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

---

This application was received electronically at the Board of Patent Appeals and Interferences on June 5, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on November 29, 2005. In response, an Examiner's Answer was mailed on February 27, 2006.

It is noted that on pages 2 and 8 of the Final Rejection mailed June 29, 2005 and on page 10 of the Examiner's Answer mailed February 27, 2006, the Pirolli (U.S. Patent 5,895,470), Call (U.S. Publication 2002-0165707 A1), Cohen (U.S. Patent 5,950,189)) and Jagdish (U.S. Patent 6,401,088 B1) references were used in the



35 U.S.C. § 103(a) rejection of claims 4, 8 and 12. However, the Jagadish reference is not included in the “Evidence Relied Upon” section of the Examiner’s Answer.

Section 1207(A)(8) of the Manual of Patent Examining Procedure (MPEP) (8<sup>th</sup> Ed., Rev. 3, August 2005) states:

(A) REQUIREMENTS FOR EXAMINER’S ANSWER.

The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1207(A)(8) is required by listing the Jagadish reference under the heading “Evidence Relied Upon.”

In addition, it is noted that the dependency of claims 2, 3, 6, 7 and 10 differs from its last amended version. Specifically:

- |          |  |
|----------|--|
| Claim 2: | Amendment of 9/13/04 refers to claim 19<br>Amendment of 4/21/05 refers to claim 18 but does not state<br>“currently amended” |
| Claim 3: | Amendment of 9/13/04 refers to claim 1<br>Amendment of 4/21/05 refers to claim 18 but does not state<br>“currently amended”  |
| Claim 6: | Amendment of 9/13/04 refers to claim 21<br>Amendment of 4/21/05 refers to claim 19 but does not state<br>“currently amended” |
| Claim 7: | Amendment of 9/13/04 refers to claim 5<br>Amendment of 4/21/05 refers to claim 19 but does not state<br>“currently amended”  |

Claim 10: Amendment of 9/13/04 refers to claim 23  
Amendment of 4/21/05 refers to claim 9 but does not state  
“currently amended”

In all of the above instances, the Appendix to the Appeal Brief agrees with the Amendment filed April 21, 2005, which states that the claims were “previously presented” not “currently amended.” It should be noted that 37 CFR § 41.37(c)(1)(viii) (2005) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for compliance with MPEP § 1207(A)(8), if appropriate, by adding the Jagadish reference to the “Evidence Relied Upon” section in a revised Examiner’s Answer;
- 2) for notification to appellants to submit a corrected Appendix to the Appeal Brief in order to replace the existing defective Appendix, or for the examiner to issue a revised Examiner’s Answer to officially correct the Appendix; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

DALE M. SHAW  
Deputy Chief Appeal Administrator  
(571) 272-9797

DMS:psb

Application 09/848,430

McGinn Intellectual Property Law Group, PLLC  
8321 Old Courthouse Road  
Suite 200  
Vienna, VA 22182-3817